

## REMARKS/ARGUMENTS

### *Status of Claims*

Claims 1-20 are currently pending in this application.

Claims 3 and 21-28 are canceled.

Claims 1, 4-7, 11, 12, 17, and 19 are hereby amended.

Claim 29 is new.

Applicants hereby request further examination and reconsideration of the presently claimed application.

### *Response to Notice of Non-Compliant Amendment*

The Applicants respectfully disagree with the Examiner that the amendments and response filed on March 23, 2006 were non-compliant. Specifically, pages 9 and 10 of the remarks section stated that support for the amendments were found in paragraphs 21 and 22 of the specification. However, in an effort to advance prosecution of the present application, the Applicants also direct the Examiner to paragraphs 6-9, 14, 16, 24-34, and 39 of the specification, Fig. 1, and original claim 21. If, after reviewing these sections of the original disclosure, the Examiner still believes the above disclosure is insufficient to support the amendments and new claim, the Examiner is invited to call the attorneys of record at the telephone number below for a more detailed explanation of how these sections of the original disclosure support the amendments and new claim.

### *35 USC § 112 Rejections*

Claims 1, 11, 12, and 19 were rejected under 35 USC § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. Specifically, claims 1, 11, 12, and 19 were rejected because

they contained the term "and/or". Claims 1, 7, 11, 12, 17, and 19 have been amended to replace the term "and/or" in the claims with the term "or".

### 35 USC § 103 Rejections

Claims 1-8 and 12-17 stand rejected under 35 USC § 103(a) as being unpatentable over *Otis* (U.S. Patent 6,085,241). Claims 9-11 and 18-20 stand rejected under 35 USC § 103(a) as being unpatentable over *Otis* in view of *Aoki* (U.S. Patent 6,757,255). Claims 1-20 stand rejected under 35 USC § 103(a) as being unpatentable over *DSL Reports* ([www.dslreports.com/stest](http://www.dslreports.com/stest)). Claims 2, 4-11, and 29 depend on claim 1 and claims 13-20 depend on claim 12. Thus, claims 1, 2, 4-20, and 29 stand or fall on the application of *Otis* and *DSL Reports* to independent claims 1 and 12.

Applicants respectfully submit that neither *Otis* nor *DSL Reports* establishes a *prima facie* case of obviousness as to the pending claims. According to MPEP § 2142, three basic criteria must be met to establish a *prima facie* case of obviousness:

First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. **Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.

Similarly, the fact that the Examiner has the burden of proof with respect to the elements of the *prima facie* case of obviousness is also well defined in MPEP § 2142:

The initial burden is on the examiner to provide some suggestion of the desirability of doing what the inventor has done. To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.

The Examiner has not met the burden of establishing the *prima facie* case of obviousness because neither *Otis* nor *DSL Reports* teach or suggest the claimed invention.

Claim 1 reads:

1. A service node for coupling a client to a network having at least one server, said service node comprising:
  - a) a gateway configured for connection to a network;
  - b) a switch configured for connection to a client;
  - c) a data routing system extending from said switch to said gateway, said switch, data routing system and gateway collectively forming a path, through said service node, configured for coupling said client to said network;
  - d) a bandwidth measurement device coupled to said gateway, said bandwidth measurement device configured for independently determining upload or download data transfer rates between said client and said gateway, and for distinguishing the upload or download data transfer rate between the client and the gateway from the upload or download data transfer rate between the client and the network.

First and foremost, the Examiner cannot meet the third prong of the obviousness test because *Otis* fails to teach or suggest the limitation that the bandwidth measurement device distinguishes the data transfer rate between the client and the gateway from the data transfer rate between the client and the network. *Otis* teaches a bandwidth manager that monitors the traffic between two networks, network A and network B in *Otis*' figure 1. By monitoring the traffic between the two networks, *Otis* is able to determine the bandwidth utilized by each of the networks when they transfer data to one another. However, *Otis* fails to disclose any method of distinguishing the data transfer rate between one of the networks and the gateway between his system and the other network (i.e. between network A and PHY 20 in *Otis*' figure 1) from the data transfer rate between the two networks. More specifically, when a decrease in bandwidth is observed, *Otis* fails to teach a system for determining whether the decrease in bandwidth is caused by components within his system or whether the decrease in bandwidth is being caused by components outside of his system, such as the servers that make up networks A and B. The ability

to make such a distinction is not trivial – it allows an internet service provider (ISP) to identify the location of a bandwidth limiting device when the client's data transfer rate falls below the specified data transfer rate. In contrast with *Otis*, claims 1 and 12 contain the limitation that the bandwidth measurement device distinguishes the data transfer rate between the client and the gateway from the data transfer rate between the client and the network. As explained in paragraph's 21 and 22 of the specification, the connection between the bandwidth measurement device and the gateway is what allows the bandwidth measurement device to distinguish between the two data transfer rates. Because *Otis* fails to teach or suggest a limitation in the claims, the Examiner cannot meet the third prong of the obviousness test and claims 1, 2, 4-13, 15-20, 29, and 30 should be allowed over the prior art.

In addition, the Examiner cannot meet the third prong of the obviousness test because *DSL Reports* fails to teach or suggest most of the limitations in the claims. *DSL Reports* teaches a system that measures the bandwidth between a client computer and a server on the Internet. However, *DSL Reports* fails to teach or suggest the components that it uses to perform the bandwidth measurement. More specifically, *DSL Reports* fails to teach or suggest a gateway, a switch, or a data routing system. Furthermore, *DSL Reports* fails to teach or suggest that its bandwidth measurement system is able to distinguish the data transfer rate between the client and the gateway from the data transfer rate between the client and the network. Like *Otis*, when a decrease in bandwidth is observed, *DSL Reports* fails to teach a system for determining whether the decrease in bandwidth is caused by the ISP components or whether the decrease in bandwidth is being caused by components outside of the ISP system, such as the servers that make up the Internet. Again, the ability to make such a distinction is not trivial – it allows the ISP to identify the location of a bandwidth limiting device when the client's data transfer rate falls below the

specified data transfer rate. In contrast with *DSL Reports*, claims 1 and 12 contain the limitation that the bandwidth measurement device contains numerous elements, including the gateway, the switch, or the data routing system. In further contrast with *DSL Reports*, claims 1 and 12 contain the limitation that the bandwidth measurement device distinguishes the data transfer rate between the client and the gateway from the data transfer rate between the client and the network. As explained in paragraphs 21 and 22 of the specification, the connection between the bandwidth measurement device and the gateway is what allows the bandwidth measurement device to distinguish between the two data transfer rates. Because *DSL Reports* fails to teach or suggest several limitation in the claims, the Examiner cannot meet the third prong of the obviousness test and claims 1, 2, 4-13, 15-20, 29, and 30 should be allowed over the prior art.

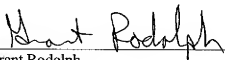
## CONCLUSION

Consideration of the foregoing amendments and remarks, reconsideration of the application, and withdrawal of the rejections and objections is respectfully requested by Applicants. No new matter is introduced by way of the amendment. It is believed that each ground of rejection raised in the Office Action dated February 7, 2006 has been fully addressed. If any fee is due as a result of the filing of this paper, please appropriately charge such fee to Deposit Account No. 21-0765, Sprint. If a petition for extension of time is necessary in order for this paper to be deemed timely filed, please consider this a petition therefore.

If a telephone conference would facilitate the resolution of any issue or expedite the prosecution of the application, the Examiner is invited to telephone the undersigned at the telephone number given below.

Respectfully submitted,

Date: 7/11/06

  
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